

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 27, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Don Vintache Inc.
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Serial No. 86186795
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Keith A. Weltsch of Scully, Scott, Murphy and Presser. P.C.,
for Don Vintache Inc.

Dominic R. Faithy, Trademark Examining Attorney, Law Office 104,
Dayna Browne, Managing Attorney.

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Before Taylor, Kuczma and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Don Vintache Inc. (“Applicant”) seeks registration on the Principal Register of the
mark DIAMONDS ON THE ROCKS (in standard characters) for

Jewelry, namely diamond jewelry in International Class
14.¹

¹ Application Serial No. 86186795 was filed on February 6, 2014, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as July 25, 2013. The word “DIAMONDS” has been disclaimed.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the registered mark SILVER ON THE ROCKS (in standard characters), with a disclaimer of "SILVER, for "jewelry made in whole or significant part of silver" in International Class 14² that it is likely to cause confusion or mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity of the goods and channels of trade.

We start our analysis with the second and third *du Pont* factors, the similarities or dissimilarities of the goods and the channels of trade. We base our determination

² Registration No. 4091859 issued on January 24, 2012; Section 8 declaration accepted March 30, 2018.

under these factors on the goods as they are identified in the registration and application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant's goods are identified as "jewelry, namely, diamond jewelry" and the goods in the cited registration are identified as "jewelry made in whole or significant part of silver." Applicant has not submitted either evidence or argument contesting the relationship between the goods or the channels of trade in which they travel. The burden, however, is on the Examining Attorney to establish the relationship between the goods. The Examining Attorney has met this burden by establishing through website evidence that the precious metal in diamond jewelry may be silver and that silver jewelry may include diamonds. See:

1. Zales The Diamond Store — www.zales.com³



2. Overstock — www.overstock.com⁴

³ Denial of Request for Reconsideration, 5 TTABVUE 6-17.

⁴ *Id.*, at 18-25.

Sterling Silver - Diamond Rings

Diamond Shape	Metal	Price		
LIMITED TIME <i>Extra</i> 15% OFF JEWELRY & WATCHES*	 WEDDING RINGS >	 INFINITY >	 HEARTS >	 BANDS >

3. Ross Simons — www.ross-simons.com⁵



.33 ct. t.w. Diamond Open Ovals Ring in Sterling Silver
RSVP: \$229.00
Compare: \$595.00 (Save 61%)



.25 ct. t.w. Diamond Highway Ring in Sterling Silver
★★★★★
Sale: \$221.25
~~\$295.00~~ (Save 25%)



.32 ct. t.w. White and Blue Diamond Evil Eye Ring in Sterling Silver
★★★★★
RSVP: \$279.00
Compare: \$695.00 (Save 59%)

and

4. Wendel's Diamond Jewelers — www.wendelsjewelers.com⁶

HOME / JEWELRY / SILVER / SILVER DIAMOND MIXABLE PENDANT 1/2 CTW / SFP1227



SILVER DIAMOND MIXABLE PENDANT

⁵ *Id.*, at 26-30.

⁶ *Id.*, at 34-37.

This evidence establishes that both “jewelry made in ... significant part of silver” and “diamond jewelry” may encompass silver jewelry containing diamonds. Thus, as identified, the goods are in-part identical.

Further, the evidence establishes that such goods are sold on websites for jewelry stores (Zales, Ross Simons and Wendels) and in online stores offering jewelry (Overstock).

The second and third *du Pont* factors weigh heavily in favor of a finding of likelihood of confusion.

B. Similarity between the marks.

We next consider the first *du Pont* factor, the similarity or dissimilarity of the marks in their entirety. In comparing the marks we must consider their appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entirety ... there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety.” *In*

re Nat'l Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *Nat'l Data Corp.*, 224 USPQ at 752. *Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). *Cf. In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (finding JOSE GASPAR GOLD “nearly identical” to GASPAR ALE once the commercial significance of the descriptive and otherwise non-dominant terms JOSE, GOLD and ALE are properly discounted).

The marks at issue here differ only in the highly descriptive or generic element “silver” and “diamonds.” Once the commercial significance of these terms is properly discounted, we are left, in both marks, with the identical phrase, “ON THE ROCKS,” which is the dominant portion of each mark. The phrase “ON THE ROCKS,” which is unitary,⁷ is defined as “(of a drink) served undiluted and with ice cubes” and “(of a relationship or enterprise) experiencing difficulties and likely to fail.”⁸

⁷ “A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.” *Dena Corp. v. Bevedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047,1052.

⁸ July 15, 2015 Office Action, Definition of “on the rocks,” from Oxford Dictionaries, www.oxforddictionaries.com/us/definition/americanenglish, Trademark Status and Document Retrieval Database (TSDR) 2, 5. Citations to the TSDR database are to the downloadable .pdf format.

Applicant concentrates on the word “ROCKS” in the phrase, arguing that the marks are not similar because the word “ROCKS” is weak. In support of this position, Applicant introduced records from seven registrations for the following marks, consisting of or containing the word “ROCKS” for jewelry items: ROCKS, GOD ROCKS, RODEO ROCKS, COUNTRY ROCKS, MUSIC ROCKS, QUEEN OF ROCKS, and JESUS ROCKS MY SOUL.⁹10 In its Request for Reconsideration, Application introduced an additional eight registrations for the same types of marks, also for jewelry items: GIVING ROCKS, CHANGE ROCKS, LOVE ROCKS NY, BLING ROCKS, BETTY ROCKS, SYD ROCKS, RECOVERY ROCKS & design, and LA ROCKS.¹¹

In all of the examples, the meaning of “rocks” is different than the meaning of the unitary phrase “ON THE ROCKS.” In each of the composite marks the word “rocks” clearly means “to be extremely enjoyable, pleasing, or effective //her new car rocks.”¹² The mark ROCKS alone has other meanings, however, none consist of the meaning

⁹ November 13, 2014 Response, TSDR 7-14.

¹⁰ Applicant also submitted a list of ten registrations without any identifying information. Since the Examining Attorney did not object to the list, it has been stipulated into the record, however, it is of extremely limited value because it does not include the title and status of the registrations, nor does it include a list of goods.

¹¹ January 5, 2016 Reconsideration Request, 4 TTABVUE 21-35.

¹² We take judicial notice of the definition of “rocks” from the *Merriam-Webster On-line Dictionary*. “Rock(s).” *Merriam-Webster.com*. Merriam-Webster, n.d. Web. 24 Sept. 2018.

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

of the phrase “ON THE ROCKS.”¹³ Given the differences in the meanings and commercial impressions of the other registrations, none of these third party registrations affects the strength of the phrase “ON THE ROCKS” in the cited mark. *cf. Coach Servs Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (Because of the “completely different meanings and commercial impressions engendered” by applicant’s COACH marks for educational software and opposer’s COACH mark for accessible luxury products, the marks are not similar.)

Applicant also contends that “the expression ‘ON THE ROCKS’ is highly diluted in connection with third party uses for marks with shared terms/phrases as well.”

To support this contention, Applicant introduced web-pages from the following sites:¹⁴

1. On the Rocks Jewelry — www.otrjewelry.com — *Id.*, at 10-11

The only use of the “On the Rocks Jewelry” is as a trade name for jewelry store in Sheridan, Wyoming. The only mark appearing on the site is OTR.

¹³ The other meanings include: (1) “to move back and forth as in a cradle,” (2) “to cause to sway back and forth,” (3) “to rouse to excitement (as by performing rock music),” and (4.) “slang – gem, diamond.” *Id.*

¹⁴ There were two other documents submitted. One had no source identifying information and the other was an advertisement for Angie’s List, which questions the existence of a jewelry store in New York.

2. OnTheRocks Designs — www.ontherocksdesigns.com¹⁵
— *Id.*, at 12

The description given for this company is an “online jewelry store” The site includes the following description of the goods: “each piece of jewelry is one-of-a-kind and individually named after a classic cocktail.”

3. On The Rocks Jewelers — www.yelp.com/biz/on-the-rocks-jewelers-san-clemente — *Id.*, at 13.

This reference is to a Yelp review of a San Clemente, California jewelry store.

4. On the Rocks — www.ontherockschicago.com — *Id.*, at 14.

The site indicates that this is a consignment shop in Chicago, Illinois which offers gems, jewelry & more.

5. Boho Wire Wrapped Jewelry On the Rocks — www.marthastewart.com/americanmade/nominee/90831/charts/boho-wire-wrapped-jewelry-on-the-rocks — *Id.*, at 17-18

This webpage identifies a “Nominee for Martha Stewart American Made Award,” which offers “[i]ntricate one of a kind hand crafted jewelry, heirloom quality wire wrapped necklace, earrings, pendants, bracelets and anklets.”

The evidence discussed above, which consists of merely five potential uses of the phrase “ON THE ROCKS,” is not sufficient to establish that the phrase carries a suggestive or descriptive connotation in the jewelry industry and thus is weak. This evidence is easily distinguishable from the evidence in *Juice Generation, Inc. v. GS Enters. LLC*, 704 F3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015), where the Court found that the twenty-six examples of registered or unregistered marks in the record

¹⁵ The URL is almost illegible.

were sufficient to establish that the use of the phrase “PEACE & LOVE” “carries a suggestive or descriptive connotation in the food industry and is weak for that reason.” *Id.*, at 1675; as well as from the evidence in *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports*, 797 F3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) where the Court found that “Jack Wolfskin's extensive evidence of third-party uses and registrations of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints.” *Id.*

Accordingly, we find that the phrase “ON THE ROCKS” has not been shown to be weak in the jewelry industry and that Applicant’s mark DIAMONDS ON THE ROCKS is similar to the mark SILVER ON THE ROCKS in the cited Registration.

II. Conclusion.

Having considered all the evidence and arguments on the relevant *du Pont* factors, whether discussed herein or not, we find that Applicant’s mark DIAMONDS ON THE ROCKS for “diamond jewelry” is likely to cause confusion with the cited registered mark SILVER ON THE ROCKS for “jewelry made in whole or significant part of silver” that it is likely to cause confusion or mistake or to deceive.

Decision: The refusal to register Applicant’s mark DIAMONDS ON THE ROCKS is affirmed.